

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed February 8, 2006, is respectfully requested. Claim 35 was cancelled, without prejudice. Claims 1-31, 33-34, 109, and 110 remain pending in this application.

Art Rejections

Claims 1-31, 33-35, 109, and 110 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Burbank et al. (USP 6,161,034). Applicants respectfully assert that these rejections are improper because the '034 patent is not prior art to the instant application. The earliest priority date to which the '034 patent might be entitled is February 2, 1999. In contrast, the instant application claims priority to U.S. Application Serial No. 09/220,618, filed December 24, 1998. The table below provides examples (not exhaustive) of specification support in the '618 application for the currently pending claims. Therefore, Burbank et al. is not prior art because Burbank et al. did not describe before December 24, 1998, a subcutaneous cavity marking device with all of the limitations of the currently pending claims.

Claim	Example of Specification Support in U.S.S.N. 09/220,618
1	10:7-19; 16:10-17:17; 18:4-9; Fig. 3A
2	15:3-9
3	15:3-9; 21:10-13
4	4:17-22; 6:9-18; 15:10-17

Claim	Example of Specification Support in U.S.S.N. 09/220,618
5	15:10-17
6	15:10-17; 21:20-24
7	4:8-16; 14:27-15:9; 21:25
8	6:19-26; 13:8-14; 18:4-9
9	4:8-16; 14:27-15:9; 18:4-9
10	6:19-26; 13:8-14; 18:4-9
11	5:9-13; 6:9-26; 11:1-20; 14:27-15:9; 16:5-9
12	6:9-26; 15:7-9
13	5:15-25; 18:4-9
14	16:17-17:17
15	10:7-19; 13:27-14:6; 17:7-11; 18:4-9
16	6:27-7:4; 12:24-13:5; 18:4-9
17	6:27-7:4; 12:24-13:5; 18:4-9
18	12:13-18; 18:4-9
19	11:1-10; 13:25-28; 18:4-9
20	13:5-18; 13:25-28; 18:4-9
21	10:11-19; 13:15-14:1; 18:4-9
22	10:11-19; 13:15-14:11; 17:18-25; 18:4-9
23	10:11-19; 13:15-14:11; 17:18-25; 18:4-9

Claim	Example of Specification Support in U.S.S.N. 09/220,618
24	13:15-24; 14:12-26; 18:4-9
25	11:1-10; 13:15-24; 18:4-9
26	10:7-19; 13:27-14:4
27	7:5-7; 13:5-8; 18:4-9
28	7:5-7; 13:5-8; 18:4-9
29	9:2-9; 18:4-9
30	9:2-9; 16:10-16; 18:4-9
31	9:2-6; 18:4-9
33	10:20-28; 18:4-9
34	10:20-28; 18:4-9
109	4:8-16; 5:15-25; 18:4-9
110	16:10-17:17; 18:4-9; Fig. 3A

Claim 1 is therefore patentably distinct from the cited art. Claims 2-31, 33-34, and 109-110 depend from claim 1 and are therefore, patentably distinct from the cited art for the same reasons. Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the claims.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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Dated: May 8, 2006

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